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| 10/021,847 | 12/13/2001 | George Kataoka | TKA0033 | 3899 |

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EXAMINER

MENON, KRISHNAN S

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 05/21/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,847

Applicant(s)

KATAOKA, GEORGE

Examiner

Krishnan S Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-10 are pending.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-35 of copending Application No. 09/925,767. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (US 4,867,993) in view of JP-5-40843.

Nordskog (993) teaches a coffee filter device comprising a blind frame (20), an open frame (38), blind frame of larger dia than the open frame (see fig 7), a body part (30) connecting the blind frame and the open frame (fig 1-6) wherein the body part is deformable with shape retaining ability, truncated conical shape (col 2 lines 1-17), a store room enclosing the extractables (14) wherein when not in use, the body could be folded in to the blind frame and the body could be expanded and restored to the original cup shape when in use as in instant claim 1 (see fig 1-7). The filter is tapered as in instant claim 2 (fig 5), the height of open frame is smaller than the blind frame to accommodate open frame completely inside the blind frame (see fig 7) as in instant claim 3, the upper end of the blind frame is connected to the lower end of the open frame as in instant claim 4, and when collapsed, the body parts would cover the peripheral faces of the open frame and the blind frame as in instant claim 5.

Nordskog (993) does not teach connecting the blind frame with the open frame by a deformable body part which would fold completely inside the blind frame in fig 7, where the blind frame is larger than the open frame, as in instant claim 1. JP'843 (408) teaches a coffee filter with open frame smaller and the blind frame (see fig 5) connected with a collapsible body part that folds completely inside. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of JP'843 in the teaching of Nordskog (993) to have the blind frame and open frame connected by a collapsible body part to obtain extra hold-up volume in the filter.

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2. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (993) in view of JP'843 (408) and further in view of Hayes (US 4,520,716).

Nordskog (993) in view of JP'843 (408) teaches all the elements of claims 6-9 as in claim 1 above, including paper for material of the filter as in instant claim 9; except for the cup-holding frame in the blind frame, and the storeroom hanging down from a hole at the bottom of the blind frame. Hayes (716) teaches such a cup holding frame in a coffee-making filter with the storeroom hanging down from a hole in the blind frame (see fig 1, 1a and 7). It would be obvious to one of ordinary skill in the art at the time of invention to have a cup-holding frame at the bottom of the filter as taught by Hayes (716) in the teaching of Nordskog (993) in view of JP '843 for securely attaching the filter to a coffee-cup, with the hanging store room to reduce spillage when loading coffee powder in it.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nordskog (993) in view of JP'843 (408) as applied to claim 1 above, and further in view of Koslow et al (US 6,103,116).

Nordskog (993) in view of JP'843 (408) teaches all the elements of claim 10 as in instant claim 1 above except for the non-woven fabric material for the filter. Koslow (116) teaches non-woven fabric for the filter in a similar coffee filter device (col 4 lines 10-15). It would be obvious to one of ordinary skill in the art at the time of invention to use non-woven fabric instead of paper as taught by Koslow (116) in the teachings of Nordskog (993) in view of JP'843 (408) for higher flow rate through the filter or for repeated use.

Response to Arguments

Applicant's arguments filed 4/16/03 have been fully considered but they are not persuasive.

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Argument re the blind frame, and the exhibit A: Exhibit teaches a blind end (part 30), which is the inside bottom of the cup. Exhibit A has a skirt around the blind end raising the blind end up a bit from its resting surface. However, examiner directs the applicants attention to lines 48-52 of col 3, where it teaches eliminating the skirt altogether. That structure would be like what Nordskog teaches as a blind end.

Re argument about the collapsible wall: Examiner agrees that Nordskog does not teach a collapsible wall that completely folds inside the blind end. The secondary ref brings in this feature.

Re the argument that Nordskog's filter, designed for use in a beverage-making machine, would not be designed to have top smaller than the bottom: Nordskog has fig 7 designed that way. However, this argument is based on an intended use. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Re argument about the Hayes ref: Hayes teaches a filter mounted on a cup. Nordskog teaches a filter that is collapsible. One would be motivated to have the collapsible filter mountable on a cup from these references.

Re argument that Koslow does not overcome the deficiencies of other references: Koslow was intended for the non-woven material only.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner
May 7, 2003


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